

Application No.: 09/777,849
Inventor: BRÖCKER et al.
Amendment of November 9, 2005
Reply to Office Action of August 11, 2005
Docket No.: 51157

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REMARKS/ARGUMENTS

Amendments to the Specification:

The Examiner objected to the Specification. More specifically, the Examiner indicated that the specification did not include a Brief Description of the Drawings and the Abstract included the term "Fig. 1" therein. The Examiner also indicated that the specification was generally not in accordance with the preferred format.

Applicants have submitted the enclosed Substitute Specification (Clean and Marked up Versions) to address the formatting issues identified by the Examiner, to add a "Brief Description of the Drawing," and to delete the term "Fig. 1" from the Abstract.

No prohibited new matter has been entered.

Amendments to the Claims

Applicants have tentatively canceled claims 1 and 2 in the instant application. Applicants respectfully retain the right to re-present such claims in the instant application or in a continuing application.

Applicants have amended Claim 3 to recite "wherein" in favor of "in which" as suggested by the Examiner and to include the limitations of claim 1.

Applicants have presented new claim 18 which depends from claim 3 and includes the limitations of original claim 2.

The rejection of Claim 2 under 35 USC §112

Applicants have tentatively canceled claim 2 thereby rendering the rejection moot.

The rejection of Claims 1 and 2 under 35 USC §102

Applicants have tentatively canceled claims 1 and 2, thereby rendering the rejection moot.

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The rejection of Claim 3 under 35 USC §103

The Examiner rejected Claim 3 under 35 USC §103 as being obvious to one having ordinary skill in the art at the time the invention was made in view of U.S. Pat. No. 4,363,753 (Bozon et al.). More specifically, the Examiner asserted that although Bozon does not disclose, teach or suggest a process of preparing the catalyst packing requiring the steps of cutting the segments of the package and assembling them to give them one or more courses, "it would have been *prima facie* obvious to one of ordinary skill in the art ...to incorporate this step into the process of Bozon...in order to obtain a multiple segments catalyst packing for used to fill the cross section of the reactor completely as desired, because 'cutting into multiple segments' is conventional and only involves routine experimentation of one having the level of ordinary skill in the art to do so." Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Likewise, it is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based. *In re Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 (Fed. Cir. 2001) (emphasis added). As stated in *Zurko*, "the [Examiner] must point to some concrete evidence in the record" to support such a finding, rather than relying upon [an] assessment of what is "well recognized" or what a skilled artisan would be "well aware." Additionally, the level of skill in the art cannot be utilized to provide the teaching, suggestion or motivation. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). Indeed, mere statements that modifications of the prior art are well within the ordinary skill of the art are not sufficient to establish a *prima facie* case of

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obviousness without some objective showing. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (emphasis added).

In the present case, the Examiner has not met the required burden to establish a *prima facie* case of obviousness. First, the Examiner has not presented sufficient prior art references that teach or suggest all of the claim limitations. Second, the Examiner has not proffered any objective evidence to illustrate that the teaching, suggestion or motivation to create the present invention emanates from the prior art and/or has not presented a convincing line of reasoning, based on objective evidence, to illustrate that the motivation to create the present invention emanates from that knowledge generally available to one having ordinary skill in the art.

As admitted by the Examiner at page 8 of the Office Action of August 11, 2005, Bozon does not disclose or teach a process for preparing a catalyst packing which requires the step of cutting segments of the package and assembling them to provide one or more courses. Similarly, Bozon does not contain a suggestion or motivation for one having ordinary skill in the art to form a package by stacking a plurality of layers on top of one another by cutting segments out of the package and assembling them as required by claim 3. Despite this fact, however, the Examiner baldly asserts "...it would have been *prima facie* obvious [to create the present invention]...because 'cutting into multiple segments' is conventional and only involves routine experimentation," and proffers no objective evidence to support such contention. The Applicants respectfully submit that the limitations of claim 3 are not "conventional" and/or require more than "routine experimentation." Indeed, Applicants respectfully submit that the if the invention of claim 3 was "conventional" and/or required only "routine experimentation," Bozon or another would have created the invention and/or would have described it; however, until disclosed by the Applicant, no one, heretofore, has done so. Additionally, conventional knowledge in the art, as disclosed in the Applicants specification has taught the skilled artisan to form catalysts packs having support structures with flow channels, to form monolithic structures, and/or utilize rigid supports.

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In sum, Bozon does not disclose, teach or suggest the present invention and the Examiner has not presented any objective evidence to illustrate that the teaching, suggestion or motivation to create the present invention emanates from the prior art. As a matter of fact, the Examiner's bald assertions that the present invention is "conventional" and requires only "routine experimentation" combined with a lack of an objective teaching, suggestion or motivation in the art to create the present invention illustrates the use of impermissible hindsight reconstruction to utilize that which the inventor taught against its teacher.

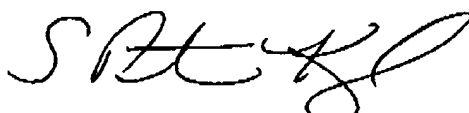
In view of the above, Applicants kindly request the Examiner to produce authority for the assertions that the limitations contained in claim 3 are "conventional" and/or require only "routine experimentation." Similarly, should the Examiner be relying on personal knowledge to support the finding of what is known in the art, Applicants kindly request an affidavit or declaration setting forth specific factual statements and explanation to support the finding in accordance with 37 CFR 1.104(d)(2).

For the reasons set forth above, the rejection should be reversed.

Conclusion

Applicants respectfully submit that the present application is in condition for allowance, which action is courteously requested.

Respectfully submitted,



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Attachments
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